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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,938	07/23/2001	Hugo De Winter	Q64233	7504

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EXAMINER

ORTIZ, ANGELA Y

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 04/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,938

Applicant(s)

DE WINTER ET AL.

Examiner

Angela Ortiz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 6, 7, 9, 16 and 18 recite a broad recitation such as a pressure range, time range, or materials selected from a group, and the claim also recites a limitation, preceded by the words "in particular" or "preferably", which is the narrower statement of the range/limitation.

Claim Objections

Claim 17 is objected to because of the following informalities: claim 17 has no period. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gruenwald et al., USP 6,214,272 in view of Jourquin et al., USP 5,662,996.

The cited primary reference teaches the basic claimed method of molding a multi-layered synthetic part including molding a first resin, molding a second resin adjacent the first resin, and then molding a third resin adjacent the second to form the

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final part. The first resin comprises polyethylene and is preferably sprayed onto the mold surface, or can be applied as a powder material onto a heated mold surface, and rotated to cover the mold surface. Each subsequent material layer can be applied as the first resin layer. Note that the first resin layer becomes the outer skin layer of the part being molded. The second material is preferably a foam core substrate. See col. 3, lines 35-45, 50-60; col. 4, lines 35-40; col. 5, line 53 to col. 6, line 35.

The primary reference does not set forth the instant claimed materials, although it does teach that other conventional materials may be used.

The added reference teaches the basic claimed multi-layered part comprising an elastomeric molded skin, a foam-backing layer, and a synthetic carrier layer. The elastomeric skin layer is polyurethane material. The foam-backing layer may be a flexible polyurethane foam material. The carrier can be produced using PU systems or SRIM systems. Note that figure 1 depicts a coarse side-facing surface for the carrier, and as the materials are the same as those claimed, it is deemed inherent within the reference the plastic carrier shows a coarse surface on its side directed toward the skin. See col. 2, lines 27-55; col. 3, lines 11-40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the materials set forth in the added reference, when performing the process set forth in the primary reference, as such materials are conventional in the art and are deemed equivalent to those disclosed, and the process lends itself to being performed with various conventional materials.

With respect to claims 3 and 10, see USP 6,214,272, for the conventionality of spraying as claimed, at col. 3, lines 35-45.

With respect to claims 2, 16, see the added reference USP 5,662,996 at col. 3, lines 20-40.

With respect to claims 8-11, see the molding techniques set forth in USP 5,662,996 at col. 3, lines 30-62.

With respect to claims 12-15, note that a textured leather appearance is desired in USP 5,662,996, see col. 4, lines 20-40. Such can be applied to the mold surface or the finally molded part as a finishing layer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Jourquin et al., USP 5,662,996.

The cited reference teaches the claimed multi-layered part comprising an elastomeric molded skin, a foam-backing layer, and a synthetic carrier layer. The elastomeric skin layer is polyurethane material. The foam-backing layer may be a flexible polyurethane foam material. The carrier can be produced using PU systems or SRIM systems. Note that figure 1 depicts a coarse side-facing surface for the carrier,

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and as the materials are the same as those claimed, it is deemed inherent within the reference the plastic carrier shows a coarse surface on its side directed toward the skin.

See col. 2, lines 27-55; col. 3, lines 11-40.

Allowable Subject Matter

Claims 4-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USP's 5,116,557; 6,013,210; 6,210,614; 6,235,228; 6,352,658; 6,419,863; 6,444,303; 6,544,449.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 703-308-4446.

The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Angela Ortiz
Primary Examiner
Art Unit 1732

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April 21, 2003